

Notice of Allowability

Application No.

10/825,450

Examiner

Janis L. Dote

Applicant(s)

CARMICHAEL ET AL.

Art Unit

1756

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address--

All claims being allowable, PROSECUTION ON THE MERITS IS (OR REMAINS) CLOSED in this application. If not included herewith (or previously mailed), a Notice of Allowance (PTOL-85) or other appropriate communication will be mailed in due course. **THIS NOTICE OF ALLOWABILITY IS NOT A GRANT OF PATENT RIGHTS.** This application is subject to withdrawal from issue at the initiative of the Office or upon petition by the applicant. See 37 CFR 1.313 and MPEP 1308.

1. ☒ This communication is responsive to Jun. 7, 2006.
2. ☒ The allowed claim(s) is/are 1-14 and 16-20.
3. ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some* c) ☐ None of the:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

* Certified copies not received: _____.

Applicant has THREE MONTHS FROM THE "MAILING DATE" of this communication to file a reply complying with the requirements noted below. Failure to timely comply will result in ABANDONMENT of this application.

THIS THREE-MONTH PERIOD IS NOT EXTENDABLE.

4. ☐ A SUBSTITUTE OATH OR DECLARATION must be submitted. Note the attached EXAMINER'S AMENDMENT or NOTICE OF INFORMAL PATENT APPLICATION (PTO-152) which gives reason(s) why the oath or declaration is deficient.
5. ☐ CORRECTED DRAWINGS (as "replacement sheets") must be submitted.
- (a) ☐ including changes required by the Notice of Draftsperson's Patent Drawing Review (PTO-948) attached
- 1) ☐ hereto or 2) ☐ to Paper No./Mail Date _____.
- (b) ☐ including changes required by the attached Examiner's Amendment / Comment or in the Office action of Paper No./Mail Date _____.
- Identifying indicia such as the application number (see 37 CFR 1.84(c)) should be written on the drawings in the front (not the back) of each sheet. Replacement sheet(s) should be labeled as such in the header according to 37 CFR 1.121(d).
6. ☐ DEPOSIT OF and/or INFORMATION about the deposit of BIOLOGICAL MATERIAL must be submitted. Note the attached Examiner's comment regarding REQUIREMENT FOR THE DEPOSIT OF BIOLOGICAL MATERIAL.

Attachment(s)

- | | |
|---|---|
| 1. <input type="checkbox"/> Notice of References Cited (PTO-892) | 5. <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 2. <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 6. <input type="checkbox"/> Interview Summary (PTO-413),
Paper No./Mail Date _____ |
| 3. <input type="checkbox"/> Information Disclosure Statements (PTO-1449 or PTO/SB/08),
Paper No./Mail Date _____ | 7. <input checked="" type="checkbox"/> Examiner's Amendment/Comment |
| 4. <input type="checkbox"/> Examiner's Comment Regarding Requirement for Deposit
of Biological Material | 8. <input checked="" type="checkbox"/> Examiner's Statement of Reasons for Allowance |
| | 9. <input type="checkbox"/> Other _____ |

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1. The examiner acknowledges the amendments to claims 1, 16, 19, and 20 and the cancellation of claim 15 set forth in the amendment filed on Jun. 7, 2006. Claims 1-14 and 16-20 are pending.

EXAMINER'S AMENDMENT

2. An examiner's amendment to the record appears below. Should the changes and/or additions be unacceptable to applicant, an amendment may be filed as provided by 37 CFR 1.312. To ensure consideration of such an amendment, it MUST be submitted no later than the payment of the issue fee.

Authorization for this examiner's amendment was given in a telephone interview with Ms. Annette L. Bade (Reg. NO. 37,029) on Jun. 19, 2006.

The application has been amended as follows:

At page 30, line 18, of the specification, delete the term "Makrolon" and insert the term -- MAKROLON --.

In claim 20, at lines 5-6, delete the phrase "at least one layer other than the imaging layer, wherein the at least one layer" and insert - an anti-curl backing layer positioned on the substrate on a side opposite to that of the imaging layer, wherein the anti-curl backing layer --; and

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at line 8, delete the phrase " 10^6 to about 10^{14} " and insert the phrase -- 10^8 to about 10^{13} --.

3. The examiner's amendment to the specification set forth in paragraph 2 supra capitalizes the trademark disclosed on page 30 to respect the proprietary nature of the mark.

The examiner's amendment to claim 20 avoids a rejection under 35 U.S.C. 112, second paragraph, for lack of antecedent basis for the term "said anti-curl backing layer" added to the claim in the amendment filed on Jun. 7, 2006. The examiner's amendment changing the surface resistivity range avoids an objection to claim 20 as being a duplicate of claim 19.

The originally filed specification provides antecedent basis for the surface resistivity range set forth in the examiner's amendment at page 27, lines 1-2.

REASONS FOR ALLOWANCE

4. The following is an examiner's statement of reasons for allowance:

The objection to the specification under 35 U.S.C. 132(a) set forth in the office action mailed on May 10, 2006, paragraph 4, has been withdrawn in response to all of

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applicants' comments set forth in the response filed on Jun. 7, 2006, page 7.

The objection to the specification set forth in the office action mailed on May 10, 2006, paragraph 5, has been withdrawn in response to amended paragraph 0074 of the specification set forth in the amendment filed on Jun. 7, 2006, and in response to the examiner's amendment to the specification set forth in paragraph 2, supra.

The rejections under 35 U.S.C. 103(a) of claims 1-14 and 17-20 over US 5,382,486 (Yu'486), as evidenced by applicants' admissions I and US 5,021,309 (Yu'309), combined with US 6,932,921 B2 (Service) and US 6,764,617 B1 (Viswanathan) and the other cited references, set forth in the office action mailed on May 10, 2006, paragraphs 7-9, have been withdrawn in response to the amendments to claims 1, 19, and 20 set forth in the amendment filed on Jun. 7, 2006, and in response to the examiner's amendment to claim 20 set forth in paragraph 2, supra. The amendments to claims 1 and 19 add the limitation of now-cancelled claim 15 that the anti-curl backing layer has "a surface resistivity of from about 10^6 to about 10^{14} ohms/sq." The amendment to claim 20 adds the limitation that the photoreceptor comprises an anti-curl backing layer that comprises a film forming polymer binder and a lignin sulfonic

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acid doped polyaniline dispersion, wherein said layer has a surface resistivity of from "about 10^8 to about 10^{13} ohms/sq."

Yu'486 teaches that its anti-curl layer "should have an electrical bulk resistivity of less than 10^8 ohm-cm," preferably "less than about 10^5 ohm-cm." Col. 17, lines 10-13. Yu'486 does not disclose that its anti-curl layer has a surface resistivity of "about 10^6 to about 10^{14} ohms/sq" or "about 10^8 to about 10^{13} ohms/sq," as recited in instant claims 1 and 19 and claim 20, respectively. Nor is there enough information in Yu'486 for a person having ordinary skill in the art to reasonably presume that the Yu'486 anti-curl layer has a surface resistivity as recited in the instant claims.

Claims 1-14 and 16-20 are allowable for the reasons discussed above.

Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Janis L.

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Dote whose telephone number is (571) 272-1382. The examiner can normally be reached Monday through Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mr. Nam Nguyen, can be reached on (571) 272-1342. The central fax phone number is (571) 273-8300.

Any inquiry regarding papers not received regarding this communication or earlier communications should be directed to Supervisory Application Examiner Ms. Claudia Sullivan, whose telephone number is (571) 272-1052.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

JLD
Jun. 19, 2006

Janis L. Dote
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PRIMARY EXAMINER
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1700